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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,090	01/28/2004	Osamu Koyasu	Q78805	9823
23373	7590	03/10/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			NGUYEN, CHAU N	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/765,090	Applicant(s) KOYASU ET AL.	
	Examiner Chau N. Nguyen	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species III, Claims 1-6 and 15-31 in the reply filed on Jan. 12th 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

2. Claim 16 is objected to because of the following informalities: in claim 16, line 1, change "a chain" to --said chain--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grulick et al. (6,293,081) in view of Epstein (6,478,229).

Grulick et al. discloses a cable (Figures 4-5) comprising a cable core, an identification element (P), and a sheath covering the cable core. Grulick et al. does not disclose the identification element comprising a plurality of radio frequency identification (RFID) elements. Epstein discloses an identification element (Figure 1) comprising a plurality of radio frequency identification elements (16). It would have been obvious to one skilled in the art to substitute the identification element (2) of Epstein with a plurality of radio frequency identification elements for the identification element (P) of Grulick et al. since it is taught by Epstein that bar codes are not dynamic carriers of information, with bar codes the stored information is static, and the information stored in bar codes on an object cannot be updated as it travels (col. 1, lines 56-64).

The modified cable of Grulick et al. also discloses the RFIDs being arranged in the cable core (re claim 2) or being adjacent to the cable core (re claim 3) and being arranged at suitable intervals along the longitudinal direction of the cable core (re claim 4), the RFIDs storing identifying information for the cable (re claim 5) and being written in and read out by electromagnetic energy (re claim 6), an integrated member containing the RFIDs in a chain (re claim 15), the integrated member with the chain of RFIDs comprising a first joining tape (4) having a first joining face and a second joining tape (6) having a second joining face connected to the first joining face so as to sandwich the RFIDs between the first and second joining tapes (re claim 16), the first and second joining faces being adhered together (re claim 17), the first and

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second joining faces being fused together (re claim 18), the RFIDs being arranged equidistantly from one another (re claim 19), and the RFIDs being approximately equal to the maximum transmittable distance between a RFID and a read/write device (re claim 20). Re claims 21 and 22, it would have been obvious to one skilled in the art to arrange the RFIDs helically around the core or to arrange them longitudinally along the cable core to meet the specific use of the resulting cable since providing a tape helically around or longitudinally along a cable core is well-known in the art.

6. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grulick et al. in view of Epstein as applied to claim 1 above, and further in view of Duron et al. (2004/0135691).

The modified cable of Grulick et al. discloses the invention substantially as claimed including the integrated member having the RFIDs, first joining tape and second joining tape in which the RFIDs are sandwiched therebetween (re claim 27). The modified cable of Grulick et al. does not disclose a pair of transmission wires (28) arranged in proximity to a plurality of RFIDs (32) (re claim 23), the wires being connected to the RFIDs ([0026]) (re claim 24), the wires comprising a plurality of twisted parts formed by the twisting of the two wires and a plurality of loop parts each formed by the two wires to adjacent to the RFID (Figure 8) (re claim 25), the twisted parts and the loop parts being formed alternately along the longitudinal direction (re claim 26).

Duron et al. discloses a package-integrated RF relay. Duron et al. discloses a pair of transmission wires (28) arranged in proximity to a plurality of RFIDs (32) (re claim 23), the

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wires being connected to the RFIDs ([0026]) (re claim 24), the wires comprising a plurality of twisted parts formed by the twisting of the two wires and a plurality of loop parts each formed by the two wires to adjacent to the RFID (Figure 8) (re claim 25), the twisted parts and the loop parts being formed alternately along the longitudinal direction (re claim 26). It would have been obvious to one skilled in the art to provide the transmission wires as taught by Duron et al. in the modified cable of Grulick et al. to provided an electrical connection to the RFIDs.

7. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein in view of Duron et al.

Epstein discloses an integrate member with a chain of RFIDs, comprising a first joining tape having a first joining face, a second joining tape having a second joining face connected to the first joining face, and a plurality of RFIDs arranged between the first and second joining tape at suitable intervals along a longitudinal direction of the tapes. Epstein also discloses that the RFIDs can be written in and read-out by transmission of electromagnetic energy (re claim 29).

Epstein does not disclose a pair of transmission wires including two conducting wires arranged between the first and second joining tapes (re claim 28). Duron et al. discloses a package-integrated RF relay. Duron et al. discloses a pair of transmission wires (28) arranged in proximity to a plurality of RFIDs (32) the wires being connected to the RFIDs ([0026]), the wires comprising a plurality of twisted parts formed by the twisting of the two wires and a plurality of loop parts each formed by the two wires to adjacent to the RFID (Figure 8) (re claim 30), the twisted parts and the loop parts being formed alternately along the longitudinal direction (re claim 31). It would have been obvious to one skilled in the art to provide the transmission

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wires as taught by Duron et al. in the integrated member of Epstein to provided an electrical connection to the RFIDs.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/773,313. Although the conflicting claims are not identical, they are not patentably distinct from each other. Specifically, claim 12 of 10/773,313 discloses the member being disposed on a designated one of the slots of the core. Accordingly, the member of '313 being arranged in the cable core or adjacent the cable core. Although '313 disclose a RFID and not RFIDs, it would have been obvious to one skilled in the art to provide a plurality of RFIDs in the cable of '313 to store more information about the cable since it has been held that merely duplicating the essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chau. N Nguyen
Primary Examiner
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